

## United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO		
10/849,186 05/20/2004 Takeru Watanabe		Takeru Watanabe	0171-i100PUS1 7245			
2292 7	2292 7590 03/14/2006			EXAMINER		
	WART KOLASCH &	CHU, JOHN S Y				
PO BOX 747 FALLS CHURCH, VA 22040-0747			ART UNIT	PAPER NUMBER		
	-	•	1752			

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<u> </u>

This action is FINAL. 2b) This action is non-final.  3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.  Disposition of Claims  4) Claim(s) 2-79.13 and 14 is/are pending in the application.  4a) Of the above claim(s) 6.7.9.13 and 14 is/are withdrawn from consideration.  5) Claim(s) is/are allowed.  6) Claim(s) 2 is/are rejected.  7) Claim(s) 2 is/are objected to.  8) Claim(s) 3-5 is/are objected to.  8) Claim(s) 3-6 is/are objected to by the Examiner.  10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.  Application Papers  9) The specification is objected to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.  Priority under 35 U.S.C. § 119  12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a) All b) Some * c) Mone of:  1. Certified copies of the priority documents have been received.  2. Certified copies of the priority documents have been received in Application No  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.		Application No.	Applicant(s)
John S. Chu  John		10/849,186	WATANABE ET AL.
Period for Reply  A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.  Estersion of time may be available under the provision of 30 FCR 11380, in no event, however, may a reply be timely filed.  If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (8) MONTHS from the mailing date of this communication. Feature to reply of specified above, the maximum statutory period will apply and will expire SIX (8) MONTHS from the mailing date of this communication. Feature to reply of specified above, the maximum statutory period will apply and will expire SIX (8) MONTHS from the mailing date of this communication. Feature to reply within the stor or scenario period period will apply and will expire SIX (8) MONTHS from the mailing date of this communication. Feature to reply within the stor or scenario period period will apply and will expire SIX (8) MONTHS from the mailing date of this communication. Feature to reply specified above, the maximum statutory period will apply and will expire SIX (8) MONTHS from the mailing date of this communication. Application is expected and the provision of the period of the communication of the communication. Application is provided will apply and the period of the communication. Set 37 CFR 1.121 (1) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.  Disposition of Claims  4) Claim(s) 2-7.9.13 and 14 is/are pending in the application.  4a) Of the above claim(s) 6.7.9.13 and 14 is/are withdrawn from consideration.  5) Claim(s) 2 is/are allowed.  6) Claim(s) 2 is/are allowed.  6) Claim(s) 2 is/are allowed.  7) Claim(s) 3-6 is/are allowed.  8) Claim(s) 2 is/are allowed.  8) Claim(s) 2 is/are allowed.  8) Claim(s) 2 is/are allowed.  9) The gravitation and an application is objected to by the	Office Action Summary	Examiner	Art Unit
Period for Reply  A SHORTENDS STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.  A SHORTENDS STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.  A SHORTEND STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.  A SHORTEND STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH (S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER THE MAILING POWER AND A STATUTORY WHITH RE SET OF THE MAILING POWER AND A STATUTORY WHITH RE SET OF THE MAILING POWER AND A STATUTORY WHITH RE SET OF THE MAILING POWER AND A STATUTORY WHITH RE SET OF THE MAILING POWER AND A STATUTORY WHITH RE SET OF THE MAILING POWER AND A STATUTORY WHITH RE SET OF THE MAILING POWER AND A STATUTORY WHITH RESET OF THE MAILING POWER AND A STATU			1
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.  Estations of them reply be available under the provious most of 3 CFR 11390, in no event, however, may a reply be timely filed.  If NO period for reply is specified above, the reasimum statutory pends will apply and will expire SIX (8) MONTHS from the mailing date of this communication. Failure to reply within the set or exerted period for rejly will. by statuke, cause the epplication become ABANDOLEGY (3d U.S. C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if smely filed, may reduce any some peach term adjustment. See 3 CFR 1.74(6).  Status  1) Responsive to communication(s) filed on 15 December 2005.  22) This action is FINAL.  2b) This action is non-final.  3) since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.  Disposition of Claims  4) Claim(s) 2-7,9.13 and 14 is/are pending in the application.  4a) Of the above claim(s) 6_7,9.13 and 14 is/are withdrawn from consideration.  5) Claim(s) is/are allowed.  5) Claim(s) 3-2 is/are rejected.  7) Claim(s) 3-2 is/are rejected.  8) Claim(s) 3-2 is/are objected to by the Examiner.  10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.  Application Papers  9) The specification is objected to by the Examiner.  10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.  Application Papers  9) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a) All b) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a) All b) Acknowledgment is made of a claim for foreign priority documents have been received in this National Stage application from the International	The MAILING DATE of this communication app	pears on the cover sheet with the c	correspondence address
Status   1  Responsive to communication(s) filed on   15 December 2005.   2a  This action is FINAL.   2b  This action is non-final.   3   Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.	A SHORTENED STATUTORY PERIOD FOR REPL WHICHEVER IS LONGER, FROM THE MAILING D  - Extensions of time may be available under the provisions of 37 CFR 1.1 after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory period  - Failure to reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailing	ATE OF THIS COMMUNICATION  (36(a). In no event, however, may a reply be tir- will apply and will expire SIX (6) MONTHS from  (6) cause the application to become ABANDONE	N. nely filed the mailing date of this communication.
2a) ☐ This action is FINAL.  2b) ☐ This action is non-final.  3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.  Disposition of Claims  4) ☐ Claim(s) 2-79.13 and 14 is/are pending in the application.  4a) Of the above claim(s) 6.7.9.13 and 14 is/are withdrawn from consideration.  5) ☐ Claim(s) 2 is/are allowed.  6) ☐ Claim(s) 2 is/are rejected.  7) ☐ Claim(s) 3-5 is/are objected to.  8) ☐ Claim(s) 3-5 is/are objected to.  8) ☐ Claim(s) 3-6 is/are objected to by the Examiner.  4application Papers  9) ☐ The specification is objected to by the Examiner.  10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.  Priority under 35 U.S.C. § 119  12) ☑ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a) ☑ All b) ☐ Some * ○ ☐ None of:  1. ☑ Certified copies of the priority documents have been received.  2. ☐ Certified copies of the priority documents have been received in Application No  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.	Status		
2a) ☐ This action is FINAL.  2b) ☐ This action is non-final.  3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.  Disposition of Claims  4) ☐ Claim(s) 2-79.13 and 14 is/are pending in the application.  4a) Of the above claim(s) 6.7.9.13 and 14 is/are withdrawn from consideration.  5) ☐ Claim(s) 2 is/are allowed.  6) ☐ Claim(s) 2 is/are rejected.  7) ☐ Claim(s) 3-5 is/are objected to.  8) ☐ Claim(s) 3-5 is/are objected to.  8) ☐ Claim(s) 3-6 is/are objected to by the Examiner.  4application Papers  9) ☐ The specification is objected to by the Examiner.  10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.  Priority under 35 U.S.C. § 119  12) ☑ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a) ☑ All b) ☐ Some * ○ ☐ None of:  1. ☑ Certified copies of the priority documents have been received.  2. ☐ Certified copies of the priority documents have been received in Application No  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.	1)⊠ Responsive to communication(s) filed on 15 D	Pecember 2005.	
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.  Disposition of Claims  4) □ Claim(s) 2-7,9.13 and 14 is/are pending in the application. 4a) Of the above claim(s) 6.7.9.13 and 14 is/are withdrawn from consideration.  5) □ Claim(s) is/are allowed. 6) □ Claim(s) 3-5 is/are objected to. 8) □ Claim(s) 3-5 is/are objected to. 8) □ Claim(s) 3-5 is/are objected to by the Examiner.  Application Papers  9) □ The specification is objected to by the Examiner. 10) □ The drawing(s) filed on is/are: a) □ accepted or b) □ objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  11) □ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.  Priority under 35 U.S.C. § 119  12) □ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) □ All b) □ Some * c) □ None of: 1. □ Certified copies of the priority documents have been received. 2. □ Certified copies of the priority documents have been received in Application No 3. □ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.  Litachment(s) 1 □ Notice of References Clied (PTO-892) 2 □ Notice of Oraftsperson's Patent Drawing Review (PTO-948) 3 □ Notice of Oraftsperson's Patent Drawing Review (PTO-148) 4 □ Internation Disclosure Statement(s) (PTO-1449 or PTO/SB/08) 7 □ Notice of Oraftsperson's Patent Drawing Review (PTO-189) 8 □ Notice of Oraftsperson's Patent Drawing Review (PTO-189) 9 □ Notice of Oraftsperson's Patent Drawing Review (PTO-189) 10 □ Notice of Oraftsperson's Patent Drawing Review (PTO-198) 11 □ Orafter □ Orafter □ Orafter □ Orafter □ O			
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.  Disposition of Claims  4) □ Claim(s) 2-7,9.13 and 14 is/are pending in the application. 4a) Of the above claim(s) 6.7.9.13 and 14 is/are withdrawn from consideration.  5) □ Claim(s) is/are allowed. 6) □ Claim(s) 3-5 is/are objected to. 8) □ Claim(s) 3-5 is/are objected to. 8) □ Claim(s) 3-5 is/are objected to by the Examiner.  Application Papers  9) □ The specification is objected to by the Examiner. 10) □ The drawing(s) filed on is/are: a) □ accepted or b) □ objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  11) □ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.  Priority under 35 U.S.C. § 119  12) □ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) □ All b) □ Some * c) □ None of: 1. □ Certified copies of the priority documents have been received. 2. □ Certified copies of the priority documents have been received in Application No 3. □ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.  Litachment(s) 1 □ Notice of References Clied (PTO-892) 2 □ Notice of Oraftsperson's Patent Drawing Review (PTO-948) 3 □ Notice of Oraftsperson's Patent Drawing Review (PTO-148) 4 □ Internation Disclosure Statement(s) (PTO-1449 or PTO/SB/08) 7 □ Notice of Oraftsperson's Patent Drawing Review (PTO-189) 8 □ Notice of Oraftsperson's Patent Drawing Review (PTO-189) 9 □ Notice of Oraftsperson's Patent Drawing Review (PTO-189) 10 □ Notice of Oraftsperson's Patent Drawing Review (PTO-198) 11 □ Orafter □ Orafter □ Orafter □ Orafter □ O	3) Since this application is in condition for allowa	nce except for formal matters, pro	osecution as to the merits is
Claim(s) 2-7.9.13 and 14 is/are pending in the application.  4a) Of the above claim(s) 6.7.9.13 and 14 is/are withdrawn from consideration.  5) Claim(s) is/are allowed.  6) Claim(s) 2 is/are rejected.  7) Claim(s) 3-5 is/are objected to.  8) Claim(s) 3-5 is/are objected to.  8) Claim(s) are subject to restriction and/or election requirement.  Application Papers  9) The specification is objected to by the Examiner.  10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.  Priority under 35 U.S.C. § 119  12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a) All b) Some * c) None of:  1. Certified copies of the priority documents have been received.  2. Certified copies of the priority documents have been received in Application No  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.  **Itachment(s)    Notice of References Cited (PTO-92)	closed in accordance with the practice under E	Ex parte Quayle, 1935 C.D. 11, 4	53 O.G. 213.
4a) Of the above claim(s) 6,7,9,13 and 14 is/are withdrawn from consideration.  5) □ Claim(s) is/are allowed.  6) □ Claim(s) 2 is/are rejected.  7) □ Claim(s) 3-5 is/are objected to.  8) □ Claim(s) are subject to restriction and/or election requirement.  Application Papers  9) □ The specification is objected to by the Examiner.  10) □ The drawing(s) filed on is/are: a) □ accepted or b) □ objected to by the Examiner.  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  11) □ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.  Priority under 35 U.S.C. § 119  12) ☑ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a) ☑ All b) □ Some * c) □ None of:  1. ☑ Certified copies of the priority documents have been received.  2. □ Certified copies of the priority documents have been received in Application No  3. □ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.	Disposition of Claims		
9) The specification is objected to by the Examiner.  10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.  Priority under 35 U.S.C. § 119  12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a) All b) Some c) None of:  1. Certified copies of the priority documents have been received.  2. Certified copies of the priority documents have been received in Application No  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.  **Ittachment(s)    Notice of References Cited (PTO-892)	<ul> <li>4a) Of the above claim(s) <u>6,7,9,13 and 14</u> is/ar</li> <li>5) Claim(s) is/are allowed.</li> <li>6) Claim(s) <u>2</u> is/are rejected.</li> <li>7) Claim(s) <u>3-5</u> is/are objected to.</li> </ul>	e withdrawn from consideration.	
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.  Priority under 35 U.S.C. § 119  12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a) All b) Some * c) None of:  1. Certified copies of the priority documents have been received.  2. Certified copies of the priority documents have been received in Application No  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.  **ttachment(s)    Notice of References Cited (PTO-892)	Application Papers		
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a) All b) Some * c) None of:  1. Certified copies of the priority documents have been received.  2. Certified copies of the priority documents have been received in Application No  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.  **Ittachment(s)    Notice of References Cited (PTO-892)	10) The drawing(s) filed on is/are: a) acc Applicant may not request that any objection to the Replacement drawing sheet(s) including the correct	epted or b) objected to by the I drawing(s) be held in abeyance. See tion is required if the drawing(s) is ob	e 37 CFR 1.85(a). jected to. See 37 CFR 1.121(d).
a) All b) Some * c) None of:  1. Certified copies of the priority documents have been received.  2. Certified copies of the priority documents have been received in Application No  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.  * See the attached detailed Office action for a list of the certified copies not received.  * Interview Summary (PTO-413) Paper No(s)/Mail Date  * Patent and Trademark Office  * Patent and Trademark Office	Priority under 35 U.S.C. § 119		
A) Notice of References Cited (PTO-892)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  Paper No(s)/Mail Date  Patent and Trademark Office  4) Interview Summary (PTO-413)  Paper No(s)/Mail Date  5) Notice of Informal Patent Application (PTO-152)  6) Other:	a) ☒ All b) ☐ Some * c) ☐ None of:  1. ☒ Certified copies of the priority document  2. ☐ Certified copies of the priority document  3. ☐ Copies of the certified copies of the priority document application from the International Bureau	s have been received. s have been received in Applicati rity documents have been receive u (PCT Rule 17.2(a)).	on No ed in this National Stage
	Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)     Paper No(s)/Mail Date      Patent and Trademark Office	Paper No(s)/Mail Da 5) Notice of Informal P 6) Other:	ate Patent Application (PTO-152)

Application/Control Number: 10/849,186

Art Unit: 1752

**DETAILED ACTION** 

Page 2

This Office action is in response to the amendment filed December 15, 2005.

1. The provisional rejection under the judicially created doctrine of obviousness-type double

patenting as being unpatentable over claims 1-9 of copending Application No. 10/679,367 (also

PGPub. 2005/0095527 A1) is withdrawn in view of the arguments by applicant.

2. The rejection under 35 U.S.C. 112, second paragraph, as being indefinite for failing to

particularly point out and distinctly claim the subject matter which applicant regards as the

invention is withdrawn in view of the arguments by applicant.

3. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by

YOKOYAMA et al 2005/0095527 Al is withdrawn in view of the amendment canceling claim

1 and now reciting claim 2 as the independent claim.

Claim Objections

4. Claims 3-5 are objected to under 37 CFR 1.75(c), as being of improper dependent form

for failing to further limit the subject matter of a previous claim. Applicant is required to cancel

the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the

claim(s) in independent form. Claim 3 recites the basic compound of claim 2, which is intended

to be a resist composition. Correction is necessary wherein the dependent claim recites proper

dependency on the full claim and not a component of a previous claim.

Claim Rejections - 35 USC § 112

Application/Control Number: 10/849,186

Art Unit: 1752

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Page 3

6. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure, which is not enabling. The components such as a resin, a photoacid generator in a resist composition as recited in the preamble of claim 2 are not recited and are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The claim merely is a compound as claimed and similar in scope to the recited withdrawn claim 9.

Correction is necessary to enable the claim.

## Allowed Claims

- 7. Claims 3-5 would be allowed over the prior art of record wherein none of the prior art references disclose the claimed resist composition comprising a basic compound as defined as formula (3) of claim 2.
- 8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chu whose telephone number is (571) 272-1329. The examiner can normally be reached on Monday Friday from 9:30 am to 6:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Cynthia Kelly, can be reached on (571) 272-1526

The fax phone number for the USPTO is (571) 273-8300.

Application/Control Number: 10/849,186

Art Unit: 1752

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Primary Examiner, Group 1700

Page 4

J.Chu March 3, 2006